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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,525	10/16/2001	Fred Burbank	senop-00401	8046
61808 7590 12/11/2007 EDWARD J. LYNCH, PATENT ATTORNEY ONE EMBARCADERO CENTER SUITE 562 SAN FRANCISCO, CA 94111			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/981,525

Applicant(s)

BURBANK ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/20/07 has been entered.

### *Terminal Disclaimer*

2. The terminal disclaimer filed on 9/20/07 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,712,775 and U.S. Patent No. 6,454,727 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 35 – 43 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "the inner lumen" in line 13. There is insufficient antecedent basis for this limitation in the claim. Previously, a "main lumen" is set forth.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 44 – 46 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,810,806 to Ritchart et al.

In regard to claims 44 – 46 and 48, Ritchart et al. an elongated probe member (36) having a proximal end, a distal end, a tissue penetrating distal tip (37) at the distal end, a longitudinal axis extending between the proximal and distal ends, a tubular sidewall, a cut out (38) in the sidewall proximal to the distal end and an inner lumen extending within at least a portion of the elongated probe member and in fluid communication with the cut out; an electrically conducting cutting wire that is slidably and rotatably disposed in the passageway, which has a distal end and a cutting loop (20) at the distal end that is configured to rotate (Figure 3) from a position within the probe member out of the cut out in the sidewall to a position exterior to the probe member in a plane transversing the longitudinal axis of the probe member (Col. 8, lines 55 – 57; Col. 7, lines 20 – 23; Col. 9, lines 48 – 53), to move longitudinally in a direction generally parallel to the longitudinal axis (Col. 9, lines 32 – 36) exterior to the probe member and to rotate from a position exterior to the elongated probe member into the probe member through the cut out in the sidewall in a plane transversing the longitudinal axis. The cutting wire is electrically connected to a source of RF electrical energy (Col. 7, lines 51 – 54). The cutting wire is formed in part of a material selected from the group consisting

of stainless steel, tungsten, platinum, and nickel-titanium alloy. A vacuum source is in fluid communication with the inner lumen (Col. 9, lines 9 – 11).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,810,806 to Ritchart et al. as applied to claim 44 above and further in view of US Patent No. 5,947,964 to Eggers et al.

In regards to claim 47, Ritchart et al. disclose a tissue acquisition instrument including an elongated shaft with a distal end having a cutting element adapted for entry into a patient's body, but fail to disclose an electrosurgical cutting element. However, Eggers et al. teaches a needle adapted for entry into a patient's body having an electrosurgical cutting wire (29; Col. 6, line 49) located on the distal end an elongated shaft. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cutting element as disclosed by Ritchart et al. to be an electrosurgical cutting wire as taught by Eggers et al. in order to simultaneously cut and cauterize while inserting the instrument into the tissue.

***Response to Arguments***

9. Applicant's arguments filed 9/20/07 have been fully considered but they are not persuasive. Applicant asserts that Ritchart et al. fail to disclose an electrically conducting wire that rotates out of a cut out in a plane that traverses the longitudinal axis of the probe member. However, the

Examiner disagrees. Ritchart et al. teach a device having a conductive cutting loop that rotates in a plane transverse to the axis of the device (Col. 7, lines 20 - 23). Ritchart et al. teach that this device can be used within a probe member having a cut out (Col. 8, lines 55 - 57). Thus, Ritchart et al. teach an electrically conducting wire that rotates out of a cut out in a plane transverse to the longitudinal axis of the probe.

***Allowable Subject Matter***

10. Claims 35 - 43 and 48 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JMLF

